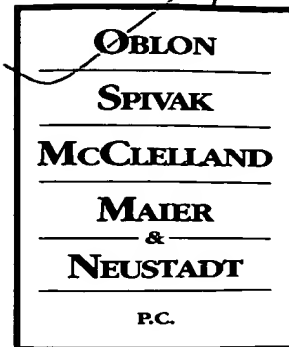


Docket No.: 7791-0092-25X DIV



ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/472,197
Applicants: Will H. GARDENSWARTZ, et al.
Filing Date: DECEMBER 27, 1999
For: COMMUNICATING WITH A COMPUTER BASED....
Group Art Unit: 2161
Examiner: HAYES, J.

ATTORNEYS AT LAW

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MAY 10 2002

Technology Center 2100

SIR:

Attached hereto for filing are the following papers:

**APPEAL BRIEF with Appendix (in Triplicate)
REQUEST FOR EXTENSION OF TIME (1 MONTH)**

Our check in the amount of \$430.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Robert C. Mattson

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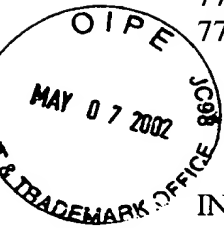
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GROUP 3600

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7791-0092-25X DIV
7791-0067-25



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

WILL H GARDENSWARTZ ET AL

: EXAMINER: HAYES, J.

SERIAL NO: 09/472,197

:

FILED: DECEMBER 27, 1999

: GROUP ART UNIT: 2161

FOR: COMMUNICATING WITH A
COMPUTER BASED ON THE
OFFLINE PURCHASE HISTORY
OF A PARTICULAR CONSUMER

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GROUP 3600

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Technology Center 2100

APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

This is an appeal of the Final Rejection dated November 8, 2001, of Claims 85-90. A
Notice of Appeal was timely filed on February 7, 2002.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Catalina Marketing Corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals. A related interference has been declared in application
number 08/498,654 filed on July 23, 1998.

III. STATUS OF THE CLAIMS

Claims 85-90 are pending in the present application and are under final rejection.

IV. STATUS OF THE AMENDMENTS

All amendments and the request for reconsideration have been entered.

V. SUMMARY OF THE INVENTION

The invention relates to a computer-readable medium for storing information for delivering a targeted advertisement comprising a first field for storing a first identifier identifying a first computer associated with the consumer and a second field linked to the first field for storing a second identifier associated with said first identifier and corresponding to an observed offline purchase history of the consumer. The purchase history includes information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired.

In a second embodiment, the first field stores a first identifier corresponding to a first computer and associated with an observed offline purchase history of a consumer. The second field stores a purchase behavior classification based on at least one selected purchase behavior criterion and the observed offline purchase history of the consumer.

In a third embodiment, the first field stores a first identifier corresponding to a targeted message and a purchase behavior classification. The second field stores a personal identification number corresponding to the consumer.

In each case, the stored data are readable by at least one processor to automatically deliver the targeted advertisement to the consumer.

VI. ISSUES

The first issue to be considered on appeal is whether Claims 85-90 are unpatentable under 35 U.S.C. § 101.

The second issue to be considered on appeal is whether Claims 85-90 are unpatentable over Scroggie et al WO 97/23838 in view of the applied secondary references.

VII. GROUPING OF THE CLAIMS

Claims 85 and 86 stand and fall together, Claims 87 and 88 stand and fall together, and Claims 89 and 90 stand or fall together.

VIII. ARGUMENT

First Issue

The Final Rejection rejected Claims 85-90 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Applicants respectfully traverse the rejection.

Briefly, Claims 85-90 recite first and second linked fields for storing data. This data may include information such as an identifier of a computer used by a consumer or an observed offline purchase history of the consumer collected at a point of sale when the offline purchase transpired. The stored data is readable by a processor to automatically deliver a targeted advertisement.

Applicants note that the outstanding office action is a mere duplicate of the May 30, 2001 office action. Thus, it is apparent that the Examiner has not given due consideration to the amendment filed by Applicants on October 1, 2001. The Examiner alleged that “the stored information representing identification information does not cause or direct a

computer to perform any functional operation and thus, is deemed to be non-function[al] descriptive material and non-statutory.” See office action, Page 2.

This same allegation was made by the Examiner in the earlier office action. As before, in response, Applicants again note that the pending independent claims have been amended to recite stored data that causes or directs a computer to perform a functional operation. Specifically, claim 85 now recites that “the information stored in the first and second fields being readable by at least one processor to automatically deliver the targeted advertisement to the first computer,” claim 87 recites “the first identifier and the purchase behavior classification being readable by at least one processor to automatically deliver the targeted advertisement to the first computer in response to receiving the first identifier from the first computer,” and claim 89 recites “the first identifier and the personal identification number being readable by at least one processor to automatically deliver the targeted message to the consumer in response to receiving the first identifier.”

The recitation of causing a processor to automatically deliver a targeted advertisement is clearly statutory subject matter. Indeed it echoes an exemplary example of statutory subject matter provided by the MPEP. According to § 2106, “a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional relationship among that data and the computing process” and is statutory even if that data represents nonfunctional material. See MPEP § 2106.

Applicants submit that not only do the present independent Claims recite a processor which is caused to function by the stored data but also that the stored data is functional in and of itself. As noted in the amendment filed April 3, 2001, the stored data is computer readable

and therefore a functional relationship exists among the data and the processor reading the data. Pages 4-5.

Therefore, Applicants respectfully submit that claims 85-90 fully comply with the requirements of 35 U.S.C. § 101. Thus, the rejection is believed to be overcome.

Second Issue

On pages 5-8 of the outstanding office action, claims 85 and 86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Scroggie et al in view of Laor; claim 87 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Scroggie et al in view of Jermyn; claim 88 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Scroggie et al in view of Jermyn and further in view of Laor, and claims 89 and 90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Scroggie et al in view of Csaszar et al. Applicants traverse these rejections.

The October 1, 2001 amendments to the claims clearly distinguish Applicants' invention from the cited references. As acknowledged in the outstanding office action on page 3, Scroggie et al fails to teach a first identifier identifying a computer associated with a consumer.

As to the allegation that a combination of the secondary references with Scroggie et al renders the present Claims obvious, Applicants note that the Examiner must explain the reasons why one of ordinary skill in the art would have been motivated to select and combine the particular applied references. *See In re Lee, 61 USPQ 1430, 1434 (CCPA 2002)*. Conclusory statements or the application of "common sense" on the part of the Examiner is not sufficient to support an obviousness rejection. *See Id at 1434-35*. Applicants submit that the Examiner has only provided conclusory statements to support the obviousness rejection.

Applicants assert that indeed there is no motivation in any of the applied references or in the knowledge generally available to one having ordinary skill in the art to modify Scroggie et al to include such a feature or any other features in claims 85-90, which Scroggie et al fail to show. With respect to Laor, this reference merely teaches the use of cookies to deliver coupons. Why would it be *obvious* to one of ordinary skill in the art to associate a cookie with an observed offline purchase history of the consumer (said purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired) based on Laor? Similar deficiencies exist with the Jermyn and Csaszar et al references. There is simply no motivation in the cited references or in the body of knowledge generally available to one of ordinary skill in the art to use the observed offline purchase history of the consumer (said purchase history including information of a purchase of the consumer collected at a point of sale when the purchase transpired) in combination with the other claimed limitations to provide the desired result of the present invention, which is to automatically deliver targeted advertisements to consumers on the basis of their observed offline purchase histories.

Accordingly, the rejections of claims 85-90 under 35 U.S.C. § 103 are believed to have been overcome.

IX. CONCLUSION

Claims 85-90 clearly recite statutory subject matter under 35 U.S.C. § 101. The combination of the references neither discloses nor suggests data, including information such as an identifier of a computer used by a consumer or an observed offline purchase history of the consumer collected at a point of sale when the offline purchase transpired, readable by a processor to automatically deliver a targeted advertisement. Accordingly, it is respectfully requested that all the rejections still pending in the Final Office Action be REVERSED.

IX. CONCLUSION

Claims 85-90 clearly recite statutory subject matter under 35 U.S.C. § 101. The combination of the references neither discloses nor suggests data, including information such as an identifier of a computer used by a consumer or an observed offline purchase history of the consumer collected at a point of sale when the offline purchase transpired, readable by a processor to automatically deliver a targeted advertisement. Accordingly, it is respectfully requested that all the rejections still pending in the Final Office Action be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER AND NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'R. Mattson', with a stylized flourish extending to the right.

Robert C. Mattson
Registration No. 42,850
Attorney of Record

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APPENDIX

85. (Three Times Amended) A computer readable medium for storing information for delivering a targeted advertisement, comprising a data structure including:

a first field for storing a first identifier identifying a first computer associated with a consumer; and

a second field linked to the first field for storing a second identifier associated with said first identifier and corresponding to an observed offline purchase history of the consumer, said purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired, the first identifier and the second identifier being readable by at least one processor to automatically deliver the targeted advertisement to the first computer in response to receiving the first identifier from the first computer.

86. (Twice Amended) The computer readable medium of Claim 85, wherein the first identifier comprises a cookie;

and wherein the second identifier comprises

a shopper card identification code of the consumer.

87. (Three Times Amended) A computer readable medium for storing information for delivering a targeted advertisement, comprising a data structure including:

a first field for storing a first identifier corresponding to a first computer and associated with an observed offline purchase history of a consumer, said purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired; and

a second field linked to the first field for storing a purchase behavior classification based on at least one selected purchase behavior criterion and the observed offline purchase

history of the consumer, the first identifier and the purchase behavior classification being readable by at least one processor to automatically deliver the targeted advertisement to the first computer in response to receiving the first identifier from the first computer.

88. (Twice Amended) The computer readable medium of Claim 87, wherein the first identifier comprises a cookie.

89. (Three Times Amended) A computer readable medium for storing information for delivering a targeted message, comprising a data structure including:

a first field for storing a first identifier corresponding to a targeted message and a purchase behavior classification based on at least one selected purchase behavior criterion and the observed offline purchase history of the consumer, said purchase history including information of a purchase of the consumer collected at a point of sale when the purchase transpired; and

a second field linked to the first field for storing a personal identification number corresponding to the consumer, the first identifier and the personal identification number being readable by at least one processor to automatically deliver the targeted message to the consumer in response to receiving the first identifier.

90. (Twice Amended) The computer readable medium of Claim 89, wherein the targeted message comprises an interactive voice response message.